

Appl. No. 09/698,362
Amtd. dated June 21, 2004
Reply to Office Action of April 21, 2004

REMARKS

In the Office Action dated April 21, 2004, claims 1-4, 6-18, 20, 22, 30-33, 35, 42-44, 46, 47, 49, 50, and 54 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,584,490 (Schuster) in view of U.S. Patent No. 6,313,864 (Tabata); and claims 5 and 21 were rejected under § 103 over Schuster in view of Tabata and U.S. Patent No. 5,907,604 (Hsu).

Applicant acknowledges the indication that claims 51-53 would be allowable if rewritten in independent form.

To establish a *prima facie* case of obviousness, at least the following two requirements must be met: (1) the asserted combination of references must teach or suggest *all* elements of the claim; and (2) there must be some motivation or suggestion to combine the references. MPEP § 2143 (8th ed., Rev. 2) at 2100-129. Neither requirement has been satisfied by the Office Action.

There is no motivation or suggestion to combine the teachings of Schuster and Tabata to achieve the invention of claim 1. Tabata proposes a solution for transmitting video images associated with videophones over a telephone line, which was recognized by Tabata as having limited bandwidth. *See* Tabata, 1:17-39. In contrast, in Schuster, such a bandwidth concern does not exist. In fact, Schuster states that access networks 112 and 114 include high bandwidth networks adapted for data communications. Schuster, 8:10-11. Examples of networks listed by Schuster include Ethernet LAN, token ring LAN, coaxial cable link, DSL, twisted pair cable, fiber optic cable, ATM link, ISDN link, and wireless links. Schuster, 8:15-19. In other words, a person of ordinary skill in the art reading Schuster would find absolutely no need or any desirability for the solution proposed by Tabata, which relates to low bandwidth telephone lines.

It is well established law that "[t]he mere fact that the prior art could be so modified would not have made the modification **obvious** unless the prior art suggested the **desirability** of the modification." *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (emphasis added). As the Federal Circuit has stated, "virtually all [inventions] are combinations of old elements." *In re Rouffet*, 149 F.3d 1350, 1357, 47

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U.S.P.Q.2d 1453 (Fed. Cir. 1998). "Most, if not all, inventions are combinations and mostly of old elements." *Id.* "Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.

Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" *Id.*

In this case, the Office Action has cited to nothing that would establish why it would be desirable to modify the teachings of Schuster to employ the techniques of Tabata. Schuster clearly states that its data networks are high bandwidth networks. In view of this, Schuster clearly contemplates that its videophone application is able to send video data without employing the bandwidth-conserving techniques of Tabata, which is designed for low-bandwidth telephone lines, a concern that clearly does not exist in Schuster. Without any suggestion of any desirability to modify Schuster in the manner proposed by the Office Action, it is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claim 1.

Moreover, the hypothetical combination of Schuster and Tabata fails to teach or suggest each and every element of claim 1. Claim 1 recites, among others, the following element: receiving information associated with at least one physical attribute of a remote party *during a packet-based call session*, where the received information represents movement of the at least one physical attribute, and the *received information is different from video data* of the at least one physical attribute. This element is not taught or suggested by either Schuster or Tabata.

Relying upon a purely piecemeal rejection of the claim, the Office Action attempted to parse this element of claim 1 into different segments, citing to different passages of Schuster and Tabata in an attempt to piece together the claim element. Such a strained reading of a claim element onto disparate portions of Schuster and Tabata, which are directed at very different subject matter, further illustrates the impropriety of the obviousness rejection of claim 1 over Schuster and Tabata.

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Although Schuster discusses a videophone application in a voice device capable of communicating over a data network, there is no indication or suggestion in Schuster of communicating *information representing movement* of a physical attribute of a remote party, where the communicated information is *different* from video data of the at least one physical attribute.

Tabata, on the other hand, is directed to communications over a conventional telephone line. See Tabata, 5:35-38. Thus, in Tabata, there is no teaching or suggestion of receiving information associated with at least one physical attribute of a party *during the packet-based call session*, and displaying an associated image (animated based on the received information) *during the packet-based call session*. Since neither Schuster nor Tabata teaches or suggests the missing element of claim 1, the hypothetical combination of the references does not teach or suggest the missing elements.

In response to this argument, the Office Action stated that "Schuster clearly teaches to receive information of a remote party during a packet based call session . . . , and Tabata clearly teaches to receive information associated with at least one physical attribute of a party" 4/21/2004 Office Action at 10-11. What this statement ignores is that Schuster fails to teach or suggest receiving information associated with at least one physical attribute of a remote party during the packet-based call session, and that Tabata teaches the communication of image-related information over a telephone line, not in a packet-based call session. Thus, clearly, neither reference teaches or suggests the receiving element of claim 1. Therefore, the hypothetical combination of Schuster and Tabata fails to teach or suggest *all* elements of claim 1. The *prima facie* case of obviousness is defective on this further ground.

Independent claim 10 is similarly allowable over the asserted combination of Schuster and Tabata. Claim 10 recites an interface to receive voice information and animation information in a *packet-based call session* from a party, where the animation information is representative of a facial expression of the party, and the animation information is *different* from video data of the facial expression. Schuster fails to disclose or suggest any of the following elements: an interface to receive animation information that is representative of a facial expression of the party, with the animation information different from video data of the facial expression; and a controller to animate

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at least a portion of the electronic representation of the image based on the animation information, and to display the animated image. Tabata fails to disclose or suggest any of the following elements of claim 10: an interface to receive voice information and animation information in a *packet-based* call session; and a controller to animate at least a portion of the electronic representation of the image based on the animation information *received in the packet-based call session*, and to display the animated image *during the packet-based call session*. Tabata is directed to communications over a conventional telephone line, and thus does not disclose or suggest the above-listed elements. Therefore, the hypothetical combination of Schuster and Tabata fails to disclose or suggest each and every element of claim 10.

Moreover, as discussed above, there is no motivation or suggestion to combine Schuster and Tabata in the manner proposed by the Office Action. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 10.

Independent claims 18 and 30 are similarly allowable over the asserted combination of Schuster and Tabata.

Independent claim 35 is also allowable over Schuster and Tabata, as the references do not teach or suggest transmitting animation information to a remote wireless telecommunications device in a packet-based call session over a wireless Internet Protocol network.


Dependent claims are allowable for at least the same reasons as corresponding independent claims.

For the foregoing reasons, all claims are in condition for allowance, which action is respectfully requested. The Commissioner is authorized to charge any additional fees, including extension of time fees, and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0082US).

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Respectfully submitted,

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